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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,756	01/16/2004	Bryan Bellafore	A1019 20348	6444

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EXAMINER
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ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/758,756	<b>Applicant(s)</b> BELLAFORE ET AL.	
	<b>Examiner</b> Jessica L. Rossi	<b>Art Unit</b> 1733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.  
     4a) Of the above claim(s) 3,6-9,12-17 and 20-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,10,11,18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/29/04,12/27/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

*ll*

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23, drawn to a method of correcting defects in a label, classified in class 156, subclass 291.
  - II. Claims 24-34, drawn to an apparatus for applying labels to containers, classified in class 156, subclass 538.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the method could be practiced by an apparatus where the labels are peeled from a continuous roll of release liner material instead of being dispensed from a stack, or alternatively, the method could be practiced by hand.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention: note a further species election must be made within the elected Group.

**Group I**

**Species A**, drawn to where the fluid is applied (pick one sub-species within the Species).

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Sub-species Ai (appears to be claim 2), drawn to applying the fluid to the container.

Sub-species Aii (appears to be claim 3), drawn to applying the fluid to the label.

**Species B**, drawn to the fluid being adhesive or non-adhesive (pick one sub-species within the Species).

Sub-species Bi (appears to be claims 5, 11, 15), drawn to the fluid being an adhesive.

Sub-species Bii (appears to be claims 6-9, 12-13, 16), drawn to the fluid being non-adhesive.

**Species C**, drawn to the type of adhesive (pick one sub-species within the Species).

Sub-species Ci (appears to be claims 18-20), drawn to the adhesive radiation curable.

Sub-species Cii (appears to be claims 21-23), drawn to the adhesive being a cold glue.

## Group II

**Species D**, drawn to where the fluid is applied (pick one sub-species within the Species).

Sub-species Di (appears to be claim 25), drawn to applying the fluid to the container.

Sub-species Dii (appears to be claim 26), drawn to applying the fluid to the label.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 24 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Mr. Faigus on 9/19/05 a provisional election was made with traverse to prosecute the invention of Group I and sub-species Ai, Bi and Ci, claims 1-2, 4-5, 10-11 and 18-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 6-9, 12-17 and 20-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Priority***

7. It is noted that the **effective filing date** of the present invention is the actual filing date of **1/16/04** since none of the prior applications listed under continuing data on the bib sheet have support for the limitations set forth in claim 1.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Roth et al. (US 6596359).

With respect to claim 1, Roth teaches a method comprising applying an adhesive 16 to a surface of a label 12 (or 14) in a non-uniform manner to cause regions of the surface to be substantially devoid of the adhesive and after applying the adhesive (Figure 11; column 6, lines 38-50) applying a fluid 20 in the regions to substantially fill the regions (Figures 2-4 and 11; column 2, lines 27-35 and 44-46 and 50-67; column 3, lines 22-32; column 6, lines 38-50; column 7, lines 25-33). Since the method of the present invention corrects defects in a label resulting from a non-uniform application of adhesive to the surface of the label by filling the non-adhesive regions with a fluid so as to form a continuous layer, the skilled artisan would have appreciated that the method of Roth would also correct defects in a label resulting from a non-uniform application of adhesive to the surface of the label.

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10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Krish et al. (US 6187432).

With respect to claim 1, Krish teaches a method comprising applying an adhesive 128 (or 130) to a surface of a label 102 in a non-uniform manner to cause regions of the surface to be substantially devoid of the adhesive and after applying the adhesive applying a fluid/adhesive 114 in the regions to substantially fill the regions (Figures 10 and 12; column 1, lines 15-17; column 4, lines 58-60; column 5, lines 6-10; column 10, lines 21-22; column 18, line 61 – column 19, line 24). Since the method of the present invention corrects defects in a label resulting from a non-uniform application of adhesive to the surface of the label by filling the non-adhesive regions with a fluid so as to form a continuous layer, the skilled artisan would have appreciated that the method of Krish would also correct defects in a label resulting from a non-uniform application of adhesive to the surface of the label.

Regarding claim 5, Krish teaches the fluid 114 being adhesive (column 23, lines 22-37; column 23, line 54 – column 24, line 2).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. as applied to claim 1 above.

Regarding claim 4, it would have been obvious to use a fluid having the same optical clarity as the adhesive so as not to negatively alter the appearance of the label.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. as applied to claim 1 above and further in view of Lewandowski et al. (US 5747551).

Regarding claim 18, Roth teaches the adhesive can be any conventional adhesive but is preferably a pressure sensitive adhesive (column 2, lines 33-35). Selection of a particular adhesive would have been within purview of the skilled artisan at the time of the invention depending on the desired characteristics thereof; however, it would have been obvious to use a radiation curable, more specifically a pressure-sensitive radiation curable adhesive, because such adhesives are known in the label art as taught by Lewandowski (column 1, lines 42-51; column 2, lines 19-20).

15. Claims 2 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krish et al. as applied to claim 1 above and further in view of Reese et al. (US 6290119).

Regarding claim 2, Krish is silent as to applying the fluid to the container in selected locations that align with the regions of the surface of the label that are substantially devoid of the adhesive. It is known in the label art to attach a label to a container using two adhesives where one adhesive is applied to the label and the other adhesive is applied to the container, as taught by Reese (column 6, lines 19-25 and 34-37).



Whether to apply both the adhesive 128 (130) and fluid/adhesive 114 to the label or apply the adhesive to the label and the fluid/adhesive to the container would have been within purview of the skilled artisan. However, it would have been obvious to apply the adhesive to the label and the fluid/adhesive to the container in the method of Krish because such is known in the art, as taught by Reese, where only the expected results would have been achieved.

Regarding claim 10, it would have been obvious to use a fluid having the same optical clarity as the adhesive so as not to negatively alter the appearance of the label.

Regarding claim 11, Krish teaches the fluid 114 being adhesive (column 23, lines 22-37; column 23, line 54 – column 24, line 2).

16. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krish et al. as applied to claim 1 above.

Regarding claim 4, it would have been obvious to use a fluid having the same optical clarity as the adhesive so as not to negatively alter the appearance of the label.

17. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krish et al. as applied to claim 1 above and further in view of Lewandowski et al.

Regarding claim 18, Krish teaches the adhesive can be just about any pressure sensitive adhesive (column 5, lines 6-10). Selection of a particular adhesive would have been within purview of the skilled artisan at the time of the invention depending on the desired characteristics thereof; however, it would have been obvious to use a radiation curable, more specifically a pressure-sensitive radiation curable adhesive, because such adhesives are known in the label art as taught by Lewandowski (column 1, lines 42-51; column 2, lines 19-20).

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18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krish et al. and Reese et al. as applied to claim 2 above, and further in view of Lewandowski et al.

Regarding claim 19, please refer to the rejection of claim 18 above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom G. Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JESSICA ROSSI**  
**PRIMARY EXAMINER**

*Jessica Rossi*